UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,057	12/30/2003	Christopher J. Lake	42P17515	9107

8791 7590 06/27/2006

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER	
LI, ZHUO H	

ART UNIT	PAPER NUMBER
2185	

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/750,057	LAKE ET AL.	
	Examiner	Art Unit	
	Zhuo H. Li	2185	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8, 11-14, 17-24, 27-30* is/are rejected.

7)☒ Claim(s) *9,10,15,16,25,26,31 and 32* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office action is in response to the amendment filed 4/27/2006.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 4, 17-18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Fischer et al. (US PAT. 6,078,402 hereinafter Fischer).

Regarding claim 1, Fischer discloses a method comprising scanning an address space to locate a structure, i.e., determining what PCI device exit and the particular configuration requirements for a new plug-in device by the configuration address space located in the configuration address register (100, figure 2) in the PCI device (65, figure 2), determining a starting address location, i.e., base address, of the structure, and accessing a register located within the structure by adding a predetermined offset to the starting location of the structure (col. 4 line 24 through col.5 line 44).

Regarding claims 2 and 4, Fischer discloses the method wherein scanning an address space includes scanning a PCI address space, and scanning an address space to

locate a structure includes scanning an address space to locate a structure that is located within a configuration space of a device (col. 4 line 24 through col. 5 line 44).

Regarding claim 17, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claims 18 and 20, the limitations of the claims are rejected as the same reasons set forth in claims 2 and 4.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 3, 5-8, 11-14, 19, 21-24 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer et al. (US PAT. 6,078,402 hereinafter Fischer) in view of Bland et al. (US PAT. 5,623,697 hereinafter Bland).

Regarding claim 3, Fischer differs from the claimed invention in not specifically teaches the step of scanning an address space includes scanning a PCI express address space. However, Bland teaches a bridge chip (34, figure 2) comprising peripheral component interconnect interface (46, figure 2) interfacing to PCI bus (30, figure 2), a direct memory access controller (50, figure 2) controlling memory accesses within system (10, figure 1), and programmable input/output register (52, figure 2), i.e., configuration address register, (col. 4 lines 36-61) wherein the direct memory access controller further comprising controllers (60 and 62) produce the memory address to the PCI bus (30) with corresponding registers, i.e., low page and high page register (col. 5 lines 20-43), wherein the direct memory access controller is capable to output to different memory location based on different bits memory addressing capacity, i.e., 8-bit mode or 16-bit mode (col. 7 lines 6-54). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the input/output interface of Fischer in having a method step of scanning an address space includes scanning a PCI express address space, as per teaching by the bridge chip of Bland, because it provides a compatible cycle or a faster version by selecting the values to read out of the high or low page registers during data transfers, and ensures the correct channel information is routed to the address bus, which allows incrementing and decrementing across any address boundary (col. 3 lines 42-46 and col. 9 lines 4-8).

Regarding claims 5-8, Fischer differs from the claimed invention in not specifically teaches the step of scanning an address space to locate a structure includes reading an 8-bit PCI capabilities pointer located inside a target device, and further determining whether the 8-bit capabilities pointer is a valid capabilities pointer, wherein the 8-bit capabilities pointer to read an 8-bit capabilities identification value, and further determining whether the read capabilities identification value matches a predetermined capabilities identification value. However, Bland teaches a bridge chip (34, figure 2) comprising peripheral component interconnect interface (46, figure 2) interfacing to PCI bus (30, figure 2), a direct memory access controller (50, figure 2) controlling memory accesses within system (10, figure 1), and programmable input/output register (52, figure 2), i.e., configuration address register, (col. 4 lines 36-61) wherein the direct memory access controller further comprising controllers (60 and 62) produce the memory address to the PCI bus (30) with corresponding registers, i.e., low page and high page register (col. 5 lines 20-43), wherein both high and low page register (82 and 84) are containing the base address, i.e., starting address, and the current addresses, a up/down counter 90 resided in the direct memory access controller counts for address bits when the system boot up, and the direct memory access controller transfer and drives address bit out onto the appropriate bus (col. 9 lines 9-54). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the input/output interface of Fischer in having a method step of scanning an address space to locate a structure includes reading an 8-bit PCI capabilities pointer located inside a target device, and further determining whether the 8-bit capabilities pointer is a valid capabilities pointer, wherein the 8-bit capabilities pointer to read an 8-bit capabilities identification

value, and further determining whether the read capabilities identification value matches a predetermined capabilities identification value, as per teaching by the by the bridge chip of Bland, because it provides a compatible cycle or a faster version by selecting the values to read out of the high or low page registers during data transfers, and ensures the correct channel information is routed to the address bus, which allows incrementing and decrementing across any address boundary (col. 3 lines 42-46 and col. 9 lines 4-8).

Regarding claims 11-14, Fischer differs from the claimed invention in not specifically teaches scanning an address space to locate a structure includes reading a 12-bit PCI express capabilities pointer located inside a target device, further determining whether the 12-bit capabilities pointer is a valid capabilities pointer, and the 12-bit capabilities pointer is a valid capabilities pointer to read a 16-bit capabilities identification value, and further determining whether the read capabilities identification value matches a predetermined capabilities identification value. However, Bland teaches a bridge chip (34, figure 2) comprising peripheral component interconnect interface (46, figure 2) interfacing to PCI bus (30, figure 2), a direct memory access controller (50, figure 2) controlling memory accesses within system (10, figure 1), and programmable input/output register (52, figure 2), i.e., configuration address register, (col. 4 lines 36-61) wherein the direct memory access controller further comprising controllers (60 and 62) produce the memory address to the PCI bus (30) with corresponding registers, i.e., low page and high page register (col. 5 lines 20-43), wherein both high and low page register (82 and 84) are containing the base address, i.e., starting address, and the current addresses, a up/down counter 90 resided in the direct memory access controller counts for address bits when the system boot up, and the direct memory access controller transfer

and drives address bit out onto the appropriate bus (col. 9 lines 9-54). In addition, the difference between Bland and the claims is the claims specifically recite the PCI bus is a 12-bit bus, however, having this sized of bus does not have a disclosed purpose nor is this size disclosed to overcome any deficiencies in the prior art. S such, the PCI bus may have been of any size, and since Bland discloses a 16-bit bus capacity (col. 9 line 66 through col. 10 line 20), the ordinary artisan would realize a possible bus size increase as the current technology would warrant. Accordingly, it would have been an obvious matter of design choice to utilize the system of Bland wherein the PCI bus is 12-bit, as disclosed supra, since applicant has not disclosed that a 12-bit PCI bys, as opposed to other sizes, overcomes a deficiency in the prior art or is for any stated purpose. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the input/output interface of Fischer in having a method step of scanning an address space to locate a structure includes reading a 12-bit PCI express capabilities pointer located inside a target device, further determining whether the 12-bit capabilities pointer is a valid capabilities pointer, and the 12-bit capabilities pointer is a valid capabilities pointer to read a 16-bit capabilities identification value, and further determining whether the read capabilities identification value matches a predetermined capabilities identification value, as per teaching by the by the bridge chip of Bland, because it provides a compatible cycle or a faster version by selecting the values to read out of the high or low page registers during data transfers, and ensures the correct channel information is routed to the address bus, which allows incrementing and decrementing across any address boundary (col. 3 lines 42-46 and col. 9 lines 4-8).

Regarding claim 19, the limitations of the claim are rejected as the same reasons set forth in claim 3.

Regarding claims 21-24, the limitations of the claims are rejected as the same reasons set forth in claims 5-8.

Regarding claims 27-30, the limitations of the claims are rejected as the same reasons set forth in claims 11-14.

Allowable Subject Matter

6. Claims 9-10, 15-16, 25-26 and 31-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed 4/6/2006 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., accessing a register located within the structure by adding a predetermined offset to the starting address location of the structure) are clearly taught by Fischer. It is noted that Fischer discloses to accessing a register (i.e., 170, 175, 180 or 185, figure 3) located within the structure (90, figure 3) by adding a predetermined offset (i.e., 190, 195, 200 or 205, figure 3) to the starting address location (i.e., base address 125, figure 3) of the structure (col. 5 lines 16-44). In addition, Applicant's assertion on the base address

indicates the location of the offset register is misleading because Fischer clearly discloses the resources' actual locations being determined by adding to base address, respectively, the offset values (col. 5 lines 35-39). Thus, Fischer discloses all of the limitations of claim 1. Accordingly, the final rejection is maintained.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zhuo H. Li whose telephone number is 571-272-4183. The examiner can normally be reached on Tues - Fri 9:00am - 6:30pm and alternate Monday..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim can be reached on 571-272-4182. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Zhuo H. Li
Patent Examiner
Art Unit 2185

MATTHEW KIM
SUPERVISORY PATENT EXAMINER
TC 2100